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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,180	12/15/2003	Steven P. Buysse	2081 CON 2 CIP CON	4369

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UNITED STATES SURGICAL,  
A DIVISION OF TYCO HEALTHCARE GROUP LP  
195 MCDERMOTT ROAD  
NORTH HAVEN, CT 06473

EXAMINER

GIBSON, ROY DEAN

ART UNIT PAPER NUMBER

3739

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/736,180

Applicant(s)

BUYSSE ET AL.

Examiner

Roy D. Gibson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6,9-12,16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6,9-12,16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/30/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

### **Formal Matters**

In the previous Office action the examiner reported that claims 8-10 and 12 were objected to only. Therefore, in the response to this Office action the applicant amended the claims to incorporate the limitations of these claims. Also on 8/15/2006 the examiner held a telephone interview with Thomas Beaton and stated that claim 12 should have also been rejected along with claims 7, 11 and 15 in light of Lottick in view of Cordis and further in view of Eggers. The applicant agreed to cancel claim 12 to place the application in condition for allowance. However, after further search, the examiner has found additional prior art to reject the pending claims and, therefore, this Office action is non-final.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 9, 11-12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lottick (5,026,370) in view of Cordis et al. (5,472,443) and Yates et al. (US H2037 H) and Aeikens et al. (5,921,916). Lottick discloses a bipolar electrosurgical instrument essentially as claimed including curved jaw members (Figures 2, 3 or 5) and tapered jaw members (Figure 4) except for the opposable seal surfaces including a non-stick coating for reducing tissue adhesion, a stop made from

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an insulative material for maintaining a separation distance between the opposable seal surfaces and the specific range of closure pressure of about 7-13 kg/cm<sup>2</sup> (col. 3, line 20-col. 5, line 68). But, Cordis et al. disclose an electrosurgical apparatus or bipolar forcep/grasper (Figure 5) having a stop (45) made from an insulating material and arranged to prevent the distal ends of the graspers or jaws from contacting each other when the forceps are closed, thus preventing a short circuit (col. 10, lines 45-55).

As to the range of closure pressure, Yates et al. disclose an electrosurgical hemostatic device wherein the range of closure pressure for forming a required tissue seal is 30 – 250 psi (30 psi is 10.2 kg/cm<sup>2</sup> and, therefore, overlaps the claimed range: see col. 3, lines 20-29 and col. 4, lines 27-35).

As to the non-stick coating on the seal surfaces, Aeikens et al. disclose an endoscope with tissue treatment capability via a laser and optical fiber wherein the distal piece of the device is provided with a non-stick coating consisting of TiN (titanium nitride) or titanium carbon nitride to avoid a sticking of tissue to the distal piece (col. 1, lines 6-46 and col. 7, lines 55-58).

Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the device of Lottick, as taught by Cordis et al., Yates et al. and Aeikens et al., to provide a stop to prevent shorting, to provide closure pressure at about 30 psi (10.2 kg/cm<sup>2</sup>) to achieve an appropriate seal pressure to tissue and to provide a non-stick coating to the energy application surfaces.

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Claims 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lottick/Cordis/Yates et al. Aeikens as applied to claim 6 above and further in view of Kirwan, Jr. (5,196,009). Lottick fails to disclose the material from which the tips of the forceps are manufactured, but Kirwan discloses non-sticking electrosurgical forceps with nickel tips, specifically Nickel 200 (col. 1, lines 5-36 and lines 59-64). Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the device of Lottick, as taught by Kirwan, to manufacture the seal surfaces from nickel, a well known non-stick material for electrosurgical sealing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy D. Gibson whose telephone number is 571-272-4767. The examiner can normally be reached on Tu-Th, 7:30 am-4:00 pm.

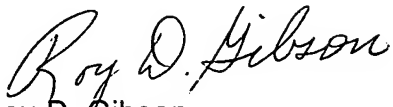
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

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Customer Service Representative or access to the automated information system, call  
800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Roy D. Gibson  
Primary Examiner  
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August 17, 2006